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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,655	12/11/2001	Ken Ohmura	KON-1694	4805

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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/014,655

Applicant(s)

OHMURA ET AL.

Examiner

Christopher D RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 6/9/03 & 6/20/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 7 has been amended to specify the process steps of the image forming method. The method states forming a coloring image from a yellow, toner image, a magenta toner image, a cyan toner image, and a black toner image, wherein forming each toner image comprises, electrically charging a photoreceptor, imagewise exposing the photoreceptor in the manner specified, developing in the manner specified, transferring the developed color image as stated in the claim, fixing the color image on the image recording material, and cleaning the photoreceptor.

The specification as filed fails to disclose this process as claimed. The specification states that the charging is uniform (spec. p. 54, l. 15; p. 55, l. 1). The instant claim permits either uniform or non-uniform charging, and non-uniform charging is not recited in the claim.

The claims also appear to recite the steps of transferring, fixing, and cleaning for each color toner image, but the specification as filed only contemplates these steps after the complete yellow, magenta, cyan, and black toner images are formed. This is apparent in the

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discussion on specification page 56, line 14 through page 57, line 13 where the specification shows concern for the presence of the previous toner image (e.g., yellow) when imaging the photoreceptor for the next color image (e.g., magenta). There would be no need for this concern if the toner image were no longer present on the photoreceptor, as is permitted by the instant claims. The claims are not described by the specification as transferring, fixing, and cleaning only occur after the totality of toner images are produced.

Claim 8 is rejected because it includes each limitation noted above in independent claim 7.

***Claim Rejections - 35 USC §§ 102 & 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cheng in US Patent 6,346,358.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng in US Patent 6,346,358 in view of *Handbook of Imaging Materials* to Diamond, pp. 160-162.

Cheng was discussed in the last Office action and that discussion remains applicable to claims 1-4 and 6 for the reasons given in the last Office action and the reasons that follow.

Claims 7 and 8 are now rejected by Cheng in view of Diamond because of the amendments to independent process claim 7. Specifically independent claim 7 now includes steps of electrically charging a photoreceptor, imagewise exposing the photoreceptor in the manner specified, developing in the manner specified, transferring the developed color image as stated in the claim, fixing the color image on the image recording material, and cleaning the

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photoreceptor. These limitations are incorporated into dependent claim 8. Diamond teaches each of these process steps noting Figure 4.1 and the supporting description in § 4.1.2.

Uniform charging would have been obvious to the skilled artisan because a patterned charge would detrimentally affect the image formed by exposure. Repetitively carrying out the steps for each color in Cheng would have been obvious in order to conduct full color copying as taught by Cheng (col. 4, l. 1-8).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the full color image of Cheng by repetitively carrying out the conventional steps disclosed by Diamond (e.g., uniform charging, exposure, development, transfer, fixing, cleaning) for each color toner because Cheng desires the formation of a full color image using electrophotographic processes and toners, and Diamond teaches the conventional process steps for this process.

Applicants traverse this rejection based upon the executed Rule 132 declaration by Ken Ohmura. In that declaration each of the toners of Cheng was reproduced (declaration ¶ 4). The declaration discusses the redispersion electroconductivity obtained with specific reference to Tables 3a and 4a. The declaration is deficient because it does not state how the redispersion electroconductivity was determined for each of the Cheng toners. Although it appears that the same process was used for this measurement as was used for the inventive toners in the specification (e.g., following the protocol specified on specification pages 8 and 9) the declaration does not clearly state this. A supplemental declaration clarifying the manner in which the redispersion electroconductivity was determined in the declaration is suggested.

Additionally, the declaration states that the designation A\* means that Cheng's toner was washed in water in an amount 10 times the toner weight while B\*\* means that Cheng's toner was washed in water in an amount 100 times the toner weight. Table 3a uses the

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designation A\*\* and B\* in the Yellow Toner for Cheng's Examples (c) and (d). It is unclear to the Examiner what is meant by these designations as they are not presented in the declaration.

The Examiner notes that the redispersion electroconductivity for Cheng are outside the scope of the values permitted by the instant claims. Appropriate clarification of the issues noted above may make a persuasive showing that Cheng does not inherently possess the claimed redispersion electroconductivity.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimori *et al.* in US Patent Application Publication 2002/0039699 in view of *Handbook of Imaging Materials* to Diamond, pp. 160-162.

Nishimori was described in the last Office action. Claim 7 has been amended as noted above. Nishimori discloses the production of full color images using a digital color copier having black, yellow, cyan, and magenta toners (§ [0324]). The copier uses a pressure contact fixing apparatus. The reference does not disclose the specific steps that the copier uses in forming the color images, but Diamond as discussed above discloses each of the claimed process steps noting Figure 4.1 and the supporting description in § 4.1.2. Uniform charging would have been obvious to the skilled artisan because a patterned charge would detrimentally affect the image formed by exposure.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the full color image of Nishimori by repetitively carrying out the conventional steps disclosed by Diamond (e.g., uniform charging, exposure, development, transfer, fixing, cleaning) for each color toner because Nishimori desires the formation of a full color image using an electrophotographic copier having color toners, and Diamond teaches the conventional process steps for producing toner images.

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Applicants traverse this rejection based on the § 119 priority claim. A certified translation has been filed of the priority document to perfect the priority claim per 37 CFR 1.55. The Examiner has carefully reviewed the translation and although the document does disclose the claimed toner it does not disclose the claimed process steps for the same reasons that the instant specification does not describe the process. Note the similar disclosure of the process in translation ¶¶ [0157] - [0167]. Specifically, the priority document only contemplates of transferring, fixing, and cleaning for each color toner image after the complete yellow, magenta, cyan, and black toner images are formed. Uniform charging is also only disclosed for the claimed charging step ¶ [0157].

Because the specification as filed and the priority document do not disclose the claimed process steps the rejection including Nishimori *et al.* in US Patent Application Publication 2002/0039699 is proper because Nishimori is still pertinent prior art.

The rejection is maintained.

### ***Conclusion***

Those rejection and objections not repeated have been overcome by applicant's remarks and/or amendments.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 703 308-2465. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703 308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and 703 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

cdr  
July 1, 2003

  
**CHRISTOPHER RODEE**  
**PRIMARY EXAMINER**